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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,679	08/08/2005	Roland Isherwood	66307-348	4119
25369 7590 09/15/2008 DYKEMA GOSSETT PLLC FRANKLIN SQUARE, THIRD FLOOR WEST 1300 I STREET, NW WASHINGTON, DC 20005				
EXAMINER				
LEWIS, JUSTIN V				
ART UNIT		PAPER NUMBER		
3725				
MAIL DATE		DELIVERY MODE		
09/15/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### Office Action Summary

**Application No.**

10/541,679

**Applicant(s)**

ISHERWOOD, ROLAND

**Examiner**

JUSTIN V. LEWIS

**Art Unit**

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)  
Paper No(s)/Mail Date 08 July 2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_



**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-10, 13-25 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,354,099 to Kaule, et. al. ("Kaule").

Kaule anticipates a security element (paper of value 1) comprising an elongate strip of a light transmitting polymeric (see col. 3, lines 47-48) substrate (security element 2), the base security document substrate being a bank note or identification card (see col. 1, lines 5-6) with at least one side being printed with identifying indicia including at least one of the repeating patterns of the metallic design (see figs. 2-4), the substrate further being provided with a magnetic feature (see col. 2, lines 3-4) and a metallic design provided by the application of a plurality of layers of metallic inks having differing characteristics to the substrate (see col. 2, lines 38-45), the magnetic feature comprising continuous layers or discontinuous layers of magnetic materials having differing characteristics (see col. 2, lines 38-45), also comprising indicia, characters, patterns, designs or geometrical shapes (see figs. 2-4), also comprising a machine readable bit pattern sequence (see col. 2, lines 47-48), the magnetic feature having an amount of magnetic material which does not vary in any cross section of the security element (see col. 2, lines 47-51), and the metallic design being provided by a



combination of metal and non-metallic regions (see col. 2, lines 47-51) which permit the transmission of light and comprising indicia, characters, patterns, designs, or geometrical shapes or a combination of the aforesaid design incorporating at least one repeating pattern provided by alternate discrete metal regions and demetallized regions in a layer covering the magnetic feature wherein the magnetic feature is not covered by metal regions (see figs. 2-4) but is overprinted with a black or colored ink (see col. 3, lines 53-54), wherein the frequency, the instantaneous amplitude and/or the maximum amplitude of the pattern varies constantly along the length of the element (see fig. 3), the design being positioned relative to the magnetic feature such that it does not overlap therewith (see figs. 2-4; note the lack of overlap between the magnetic areas 3 and the recesses 5), wherein the design of the magnetic feature and the pattern of the metallic feature are complementary (see figs. 2-3; note that recesses are absent in magnetic areas, and vice-versa), and the magnetic feature and the pattern of the metallic feature combine to comprise an authenticating feature (see figs. 2-4; note the totality of the combination), the security element further comprising a layer which has a functional effect, such as luminescence or IR absorbing being applied to the element (see col. 2, lines 21-25; see also col. 2, line 67- col. 3, line 1).

***Claim Rejections - 35 USC § 103***

3. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule in view of U.S. Patent Application Publication No. 2002/0090556 to Jotcham, et. al. ("Jotcham").



Kaule discloses the security element of claim 9, but fails to disclose a layer of optically variable, photochromic or thermochromic material and a masking layer.

Jotcham teaches an optically variable masking layer (see paragraph 17, lines 5-6).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to dispose a Jotcham optically variable masking layer over the Kaule security element, in order to disguise the appearance of the security element when viewed by the naked eye, as explicitly taught by Jotcham (see paragraph 17).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN V. LEWIS whose telephone number is (571)270-5052. The examiner can normally be reached on M-F 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Derris H Banks/  
Supervisory Patent Examiner, Art Unit 3725  
/JVL/